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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,693

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Richard A. Baker

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DRINKER BIDDLE & REATH LLP
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EXAMINER

RANKINS, WILLIAM E

ART UNIT

PAPER NUMBER

4172

MAIL DATE

DELIVERY MODE

10/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/804,693

Applicant(s)

BAKER ET AL.

Examiner

William E. Rankins

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4172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 10-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 10-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/1/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Detailed Action

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 are drawn to a method of reversing the clearance of a previously executed derivatives trade, classified in class 705, subclass 37.
- II. Claims 10-19 are drawn to a method of generating a graphical user interface, classified in class 345, subclass 650.
- III. Claims 20-24 are drawn to a method for reconciling unmatched records, classified in class 705, subclass 37.

1. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the graphical user interface of claims 4 and 6 are only required to be transmitted or used whereas claim 10, and its dependents, are drawn to its creation or generation.. The subcombination has separate utility such as data entry for any number of business purposes involving a buyer and a seller or supplier of goods and services..

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2. Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the graphical user interface of claim 20 is only required for display whereas claim 10, and its dependents, are drawn to its creation or generation.. The subcombination has separate utility such as data entry for any number of business purposes involving a buyer and a seller or supplier of goods and services.

3. Inventions I and III are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed perform a different function and have a different effect as I reverse cleared transactions and III reconciles unmatched transactions. The inventions are also mutually exclusive as one can be used without the other.. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

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Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Brian Rupp on October 4th and 10th, 2007 a non-provisional election was made without traverse to prosecute the invention of Group I (claims 1-9). Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

A review of the claims and updated search necessitated the rejections below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Penney et al. (2003/0069836).

As per claim 1;

Penney et al. discloses:

A method for reversing the clearance of a previously executed derivatives (paragraph 0005) trade, in which a buyer and a seller have executed the trade in a derivatives exchange or in an over the counter market, the method comprising: storing data, in a memory, indicating that the executed trade has been accepted (paragraph 0101);

in response to an electronic request from a user, retrieving the accepted-trade data from the memory (paragraph 0180);

displaying the retrieved data to the user on a user interface (paragraph 0018);

receiving an input from the user indicating that the acceptance of the executed trade should be negated (paragraph 0087);

in response to the received input, generating an offsetting transaction record for the buyer and an offsetting transaction record for the seller, in which the buyer's and seller's roles are reversed from what they were in the executed trade (paragraph 0119); and

repeating the storing step using the offsetting transaction records for the buyer and seller, thereby negating the acceptance of the executed trade (paragraph 0015,

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0019).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penney et al. (2003/069836) as applied to claim 1 above, and further in view of Tupper et al. (2003/0093362).

As per claim 2;

Penney et al. discloses:

The method of claim 1.

Penney does not disclose:

further comprising:

receiving the buyer's record of the executed trade and the seller's record of the executed trade;

comparing the buyer's record and the seller's record to determine whether certain fields in the buyer's record match equivalent fields in the seller's record; and

based on the comparing step, accepting the executed trade.

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However, Tupper et al. discloses:

A system, which receives the buyers and sellers records of a trade and matches the information in the record to confirm the trade (paragraph 0010).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Penney et al. and Tupper et al.

One of ordinary skill in the art would be motivated to do so in order to provide a system that can easily match and confirm trades to prevent mistakes and makes preparations for auditing.

As per claim 3;

Penney et al. discloses:

The method of claim 1.

Penney does not disclose:

further comprising:

receiving a matched trade from an electronic exchange or over the counter market, wherein the matched trade represents the executed trade; and
accepting the matched trade.

However, Tupper et al. discloses:

An over the counter trade received from a system with a matching program (fig.1, component 18) by a trading firm (Fig. 1, component 30) and confirmed (paragraph 0039, 0040).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Penney et al. and Tupper et al.

One of ordinary skill in the art would be motivated to do so in order to outsource services that others can perform and which increase efficiency and reduce expenditures.

As per claim 4;

Penney et al. discloses:

The method of claim 1.

Penney does not disclose:

wherein the displaying step comprises:

transmitting, to a remote computer, a graphical user interface comprising a plurality of rows and columns, wherein each row represents a particular derivatives trade that had been previously executed and accepted, and each column represents a piece of information concerning the particular trade.

However, Tupper et al. discloses:

A confirmation summary screen that is a user interface and represents a completed trade (paragraph 0019, Fig. 5). The system can be used with derivatives trades (paragraph 0005).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Penney et al. and Tupper et al.

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One of ordinary skill in the art would be motivated to do so in order to provide efficient communication between the buyer and the seller when making trade amendments and to easily view previous or current trades.

As per claim 8;

Penney discloses:

The method of claim 1 and;

the method further comprising:

displaying a message to the second party on a display screen, wherein the message queries the second party regarding whether the second party agrees that the executed trade should not have been accepted; and

receiving an input from the second party that indicates that the second party agrees that the executed trade should not have been accepted (paragraph 0017, 0018).

Penney does not disclose:

wherein the buyer and the seller are participants in a clearinghouse, wherein there is a first party to the executed trade, who is either the buyer or the seller, and there is a second party to the executed trade, who is on the opposing side of the first party, wherein the user represents the first party to the executed trade.

However, Tupper et al. discloses:

Trades sent to a third party clearinghouse for settlement (paragraph 0004).

The date the trade was first executed (Fig. 6B).

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A record of the transaction (Fig. 6B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Penney et al. and Tupper et al.

One of ordinary skill in the art would be motivated to do so in order to promote the ability of the buyer and seller to negotiate amendments to previously executed trades prior to net settlement which would reduce the possibility of making another trade which may need to be negated once again.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Penney et al. (2003/069836) as applied to claim 1 above, and further in view of Tupper et al. (2003/0093362), and further in view of Sanders (2001/0042036), and further in view of Sobek (2003/0144942).

As per claim 5;

Penney et al. discloses:

Negating the acceptance of previously executed trades (paragraph 0119).

Penney et al. does not disclose:

The method of claim 2, wherein the buyer and seller represent participants of a clearinghouse or are customers of clearinghouse participants;

wherein the buyer bought the derivative from the seller on a first trading day;

wherein the step of receiving the buyer's and the seller's records of the executed trade comprises receiving, in the buyer's record and in the seller's record, data that identifies the commodity that was traded, identifies the buyer and the seller, and identifies the price at which the commodity was traded;

However, Tupper et al. discloses:

Trades sent to a third party clearinghouse for settlement (paragraph 0004).

The date the trade was first executed (Fig. 6B).

A record of the transaction (Fig. 6B).

Penney also does not disclose:

wherein the step of accepting the executed trade comprises assuming one or more obligations of the buyer and seller with respect to the executed trade;

However, Sanders discloses:

An options clearing entity that guarantees all obligations under the contract relative to the trade (paragraph 0028).

Penney also does not disclose:

the method further comprising:

tallying up all of the gains and losses for both the buyer and seller at the end of the first trading day, including the trade carried out between the buyer and seller, and crediting or debiting the bank accounts of the buyer and seller based on the results of the tallying step;

tallying up all of the gains and losses for both the buyer and seller at the end of a second trading day, taking into account offsetting transaction records, and crediting or

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debiting the bank accounts of the buyer and seller based on the results of the tallying step.

However, Sobek discloses:

A trade forwarded to an investment services system for processing and net settlement. (paragraph 0069-0071).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Penney et al., Tupper et al., Sanders and Sobek.

One of ordinary skill in the art would be motivated to do so in order to have a clearinghouse provide settlement services for both the original and the amended trades.

7. Claims 6, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penney et al. (2003/069836) as applied to claim 1 above, and further in view of Tupper et al. (2003/0093362), and further in view of Sobek (2003/0144942).

As per claim 6;

Penney et al. discloses:

Negating the acceptance of previously executed trades (paragraph 0119).

Penney et al. does not disclose:

The method of claim 2, wherein the buyer and seller represent participants of a clearinghouse or are customers of clearinghouse participants;

wherein the buyer bought the derivative from the seller on a first trading day;

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wherein the step of receiving the buyer's and the seller's records of the executed trade comprises receiving, in the buyer's record and in the seller's record, data that identifies the commodity that was traded, identifies the buyer and the seller, and identifies the price at which the commodity was traded;

However, Tupper et al. discloses:

Trades sent to a third party clearinghouse for settlement (paragraph 0004).

The date the trade was first executed (Fig. 6B).

A record of the transaction (Fig. 6B).

Penney also does not disclose:

the method further comprising:

tallying up all of the gains and losses for both the buyer and seller at the end of the first trading day, including the trade carried out between the buyer and seller, and crediting or debiting the bank accounts of the buyer and seller based on the results of the tallying step;

tallying up all of the gains and losses for both the buyer and seller at the end of a second trading day, taking into account offsetting transaction records, and crediting or debiting the bank accounts of the buyer and seller based on the results of the tallying step.

However, Sobek discloses:

A trade forwarded to an investment services system for processing and net settlement. (paragraph 0069-0071).

Penney also does not disclose:

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wherein the displaying step further comprises transmitting, to a remote computer, a graphical user interface comprising a plurality of rows and columns, wherein each row represents one of a plurality of derivatives trades that had been previously executed and accepted, and each column contains one of a plurality of pieces of information concerning each of the plurality of derivatives trades.

However, Tupper et al. discloses:

A confirmation summary screen that is a user interface and represents a completed trade (paragraph 0019, Fig. 5). The system can be used with derivatives trades (paragraph 0005).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Penney et al., Tupper et al., and Sobek.

One of ordinary skill in the art would be motivated to do so in order to promote the ability of the buyer and seller to negotiate amendments to previously executed trades prior to net settlement which would reduce the possibility of making another trade which may need to be negated once again.

As per claim 7;

Penney et al. does not disclose:

The method of claim 6, wherein the graphical user interface is a web page, and the plurality of pieces of information comprises:

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the date on which the plurality of trades were accepted, the broker that executed the trade underlying the trade, and the commodity that was traded.

However, Tupper et al. discloses:

A graphical user interface comprising information on a plurality of trades (Figs. 5 and 6B, paragraphs 0019 and 0021).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Penney et al., Tupper et al., and Sobek.

One of ordinary skill in the art would be motivated to do so in order to link remote computers representing the buyer and the seller and provide complete information regarding the trade to both.

As per claim 9;

Penney discloses:

displaying a message to the second party on a display screen, wherein the message queries the second party regarding whether the second party agrees that the executed trade should not have been accepted; and

receiving an input from the second party that indicates that the second party agrees that the executed trade should not have been accepted (paragraph 0017 and 0018).

Negating the acceptance of previously executed trades (paragraph 0119).

Penney does not disclose:

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The method of claim 2,
wherein the buyer and seller represent participants in a clearinghouse;
wherein the buyer and seller executed the trade on a first trading day;
wherein the step of receiving the buyer's and the seller's records of the executed trade comprises receiving, in the buyer's record and in the seller's record, data that identifies the commodity being traded, identifies the buyer and the seller, and identifies the price at which the commodity was traded; the method further comprising:

wherein the displaying step further comprises transmitting, to a remote computer, a graphical user interface comprising a plurality of rows and columns, wherein each row represents one of a plurality of trades that had been previously executed and accepted, and each column contains one of a plurality of pieces of information concerning each of the plurality of trades;

However, Tupper et al. discloses:

Trades sent to a third party clearinghouse for settlement (paragraph 0004).

The date the trade was first executed (Fig. 6B).

A record of the transaction (Fig. 6B).

Penney also does not disclose:

tallying up all of the gains and losses for both the buyer and seller at the end of the first trading day, including the executed trade, and crediting or debiting the bank accounts of the buyer and seller based on the results of the tallying step;

tallying up all of the gains and losses for both the buyer and seller at the end of a second trading day, taking into account offsetting transaction records, and crediting or

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debiting the bank accounts of the buyer and seller based on the results of the tallying step.

However, Sobek discloses:

A trade forwarded to an investment services system for processing and net settlement. (paragraph 0069-0071).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of this invention to combine the methods and systems of Penney et al., Tupper et al., and Sobek.

One of ordinary skill in the art would be motivated to do so in order to promote the ability of the buyer and seller to negotiate amendments to previously executed trades prior to net settlement which would reduce the possibility of making another trade which may need to be negated once again.

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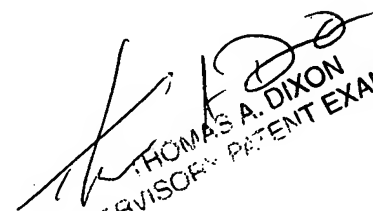
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM, off alt Fridays beg 6/15/07.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William E Rankins
Examiner
Art Unit 3609


THOMAS A. DIXON
SUPERVISOR, PATENT EXAMINER